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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/594,753 | 05/22/2008 | Bernd Ullmann | KURARAY-0014 | 3795 |
| 23599 7590 04/06/2011 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201 | | | | |
| EXAMINER | | | | |
| HALPERN, MARK | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1741 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 04/06/2011 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/594,753

Applicant(s)

ULLMANN ET AL.

Examiner

Mark Halpern

Art Unit

1741

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 March 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-4, 7, 9-11, 17-19 and 22-26

Claim(s) withdrawn from consideration: 12-16, 20 and 21

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☒ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). 3/29/2011
 13. ☐ Other: _____

/Mark Halpern/
 Primary Examiner
 Art Unit: 1741

Continuation of 11. does NOT place the application in condition for allowance because:

The Restriction issued on 7/29/2010 is proper. The Restriction was made FINAL on 7/29/2010.

Applicant's election with traverse of invention I, drawn on claims 1-4, 7-11, 17-19, in the reply filed on 7/16/2010 was acknowledged. The traversal was on the ground(s) that the disclosure is in German language and that no rationale is presented for the alleged obviousness or anticipation.

This was not found persuasive. A translation of the document EP 0 697 622 was obtained. The inventions listed as Groups I - IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1 is either obvious over or anticipated by EP 0 697 622. Accordingly, the special feature linking the two inventions, pulp of freeness claimed, internal sizing with AKD or with resin, water soluble binder, does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore, the restriction is appropriate. The requirement is still deemed proper and is therefore made FINAL.

Claims 1-4, 7, 9-11, 17-19, 22-26 rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is proper. See Office Action issued on 12/29/2010. In the present instance, claim 1 recites the broad recitation "water soluble binders", and the claim also recites "ethylene-vinyl alcohol copolymers, acetalized ethylene-vinyl alcohol copolymers, acetalized polyvinyl alcohols, polyvinyl butyrals, cationically modified polyvinyl alcohols containing silanol groups, acetalized cationically modified polyvinyl alcohols containing acetalized silanol groups, polyvinyl alcohols containing carboxyl groups, and mixtures thereof" each of which is the narrower statement of the limitation.

Claims 1-4, 7, 9-11, 17-19, 22-26 rejection under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schoeller (EP 0 545 043) is proper. See Office Action issued on 12/29/2010. The Rejection should have not included withdrawn claims 12-16. (translation of patent EP 0 545 043 obtained by the Office is used in the Office Action; copy of the translation provided to the Applicants).

Schoeller discloses paper sized with alkenyl succinic anhydride (ASA) and/or alkylketene dimers (AKDs) and includes pulps having a freeness of 350 SR. The paper is also impregnated with polyvinyl alcohol applied in an aqueous solution, which is water-soluble binder (Pages 5-6, and Examples 1-3, Pages 8-12). The claims are considered as product by process claims since the paper is produced by a process from strongly beaten pulps with a degree of beating of 150 SR to 900 SR.

In the event any differences can be shown for the product of the product-by-process claims 1-4, 7, 9-11, 17-19, 22-26, as opposed to the product taught by the reference Schoeller, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

Applicants allege that the cited prior art, Schoeller, does not disclose penetration resistance to fats and oils.

Penetration resistance to fats and oils is not claimed. Also, the penetration resistance to fats and oils is a method and not a structural limitation.

Applicants allege that Schoeller does not disclose water soluble binders recited in claim 1.

Schoeller discloses the paper is impregnated with polyvinyl alcohol applied in an aqueous solution, which is a water-soluble binder.

Applicants allege that the claims are not product-by-process claims.

The claims are considered as product by process claims since the paper is produced by a process from strongly beaten pulps with a degree of beating of 150 SR to 900 SR.

Continuation of 12. The IDS submitted on 3/29/2011 includes five foreign prior art documents, the review of which requires consideration at this time.